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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/782,107	02/13/2001	Mihal Lazaridis	555255012189	3129
7590 07/03/2007				
David B. Cochran, Esq. Jones, Day, Reavis & Pogue North Point, 901 Lakeside Avenue Cleveland, OH 44114				
			EXAMINER	
			REILLY, SEAN M	
			ART UNIT	PAPER NUMBER
			2153	
			MAIL DATE	DELIVERY MODE
			07/03/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/782,107

Applicant(s)

LAZARIDIS ET AL.

Examiner

Sean Reilly

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 April 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 90-109 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 90-109 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This Office action is in response to Applicant's amendment and request for reconsideration filed on June 28, 2006. Claims 90-109 are presented for further examination.

Response to Arguments

Applicant asserts that the AirMobile system fails to disclose explicitly sending a *reply* message and thus fails to disclose various features of the claimed invention. Examiner respectfully disagrees. Applicant has failed to embrace the full functionality of the AirMobile system. In particular the AirMobile system extends the email send and receive capabilities of the traditional LAN based Lotus cc:Mail system to the wireless environment (AirMobile client documentation pgs 5-6, 8. In particular the AirMobile Client states on pg 5, "Motorola AirMobile Wireless Comm Client for cc:Mail is optimized for the wireless. The software implements a powerful and efficient wireless transport and application protocol, enabling users of Lotus cc:Mail Mobile for Windows to send and receive e-mail messages quickly and easily." AirMobile further states "With Motorola AirMobile software you simply turn on your wireless network adapter, load cc:Mail Mobile and **you're connected to your cc:Mail server back in the office, uploading messages you have sent to your LAN mail server or downloading messages from your LAN mail server to your inbox**" (emphasis added). The AirMobile system clearly provides all traditional LAN based email functionality to the user, e.g. send, receive, forward, and reply, except in the wireless environment. Applicant must consider the full breadth of the teaching in view of the knowledge of one ordinary skill in art at the time of Applicant's invention. Moreover Applicant must consider what is implicitly taught. Examiner

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maintains that AirMobile clearly teaches allowing users to perform traditional email functions in the wireless environment when the AirMobile disclosure is considered as a whole and in view of the knowledge of one of ordinary skill in the art at the time of Applicant's invention. Thus, Examiner maintains that the AirMobile Server and Client documentation disclosed the traditional feature of sending a reply to an email.

Furthermore Applicant's representatives are well aware of the functionality that was contained in Motorola's AirMobile system at the time of Applicant's invention. In a related application Applicant argues that the system disclosed by Eggleston et al. in U.S. Patent Number 5,958,006 is the same system disclosed by the AirMobile Server and Client manuals (see Application 09/783,726 and the response filed April 25, 2005 pgs 13-16). Eggleston explicitly disclosed the act of replying to an email (Figure 9 and Col 3, lines 35-56). Thus, Examiner maintains that based on Applicant's own arguments, the AirMobile system allows users to reply to email messages.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

1. **Claims 90-109 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 126-212 of copending Application No. 10/207,418.** Although the conflicting claims are not identical, they are not patentably distinct from each other. Refer to the tables for specific claim mappings of equivalent claim language in the exemplarily claims below.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Co-pending Application # 10/207,418	Instant Application # 09/782,107
126. A method of replicating data items from a computer system to a mobile data communication device of a user, the method comprising the steps of :	90. A method of redirecting information between a messaging host system and a wireless mobile data device that is associated with a computer connected over a network to the messaging host system, the method

	comprising the steps of:
Receiving a data item at the computer system and automatically generating a notification pertaining to the data item upon receipt of the data item, the data item having an address associated with a mailbox of the user; and	Receiving an automatically generated notification at a redirector component indicating receipt of a user data item by the messaging host system, wherein the mail item is addressed to a data store that is associated with the messaging host system;
Pushing the data item from the computer system to the mobile data communication device of the user, the pushing including receiving the automatically generated notification pertaining to the data item by a redirector component and sending an instance of the data item by the redirector component to the mobile data communication device of the user.	Sending the encrypted copy of the user data item from the redirector component to the wireless mobile data device.

2. **Claims 90-109 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 102-129 of copending Application No. 09/782,107.** Although the conflicting claims are not identical, they are not patentably distinct from each other. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Co-pending Application # 09/783,726	Instant Application # 09/782,107
102. A method of pushing user data items from a messaging host system to a wireless mobile data device that is associated with a computer connected over a network to the messaging host system, the method comprising the steps of:	90. A method of redirecting information between a messaging host system and a wireless mobile data device that is associated with a computer connected over a network to the messaging host system, the method comprising the steps of:
Receiving an automatically generated notification at a redirector component indicating receipt of a user data item by the messaging host system, wherein the user data item is addressed to a data store that is associated with the messaging host system and is viewable via the computer;	Receiving an automatically generated notification at a redirector component indicating receipt of a user data item by the messaging host system, wherein the mail item is addressed to a data store that is associated with the messaging host system and is viewable via the computer;
Sending the copy of the user data item form the redirector component to the wireless mobile data device.	Sending the encrypted copy of the user data item from the redirector component to the wireless mobile data device.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 90-109 are rejected under 35 U.S.C. 103(a) as being unpatentable over AirMobile Server (AirMobile Wireless Software for Lotus cc:Mail, Communication Server Guide, Motorola, 1995), in view of AirMobile Client (AirMobile Wireless Software for Lotus cc:Mail, Communication Client Guide, Motorola, 1995), and Carthy et al. (MAPI Developers Forum post "MAPI Notification" April 12, 1996; hereinafter Carthy) and Eggleston et al. (U.S. Patent No. 5,764,899, hereinafter "Eggleston") and Murota (U.S. Patent No. 6,289,105).

Note, the AirMobile Server and AirMobile Client guide present different aspects of the same system, and are therefore are treated as a single system for the purposes of this rejection. They are hereinafter referred to with specific citations to the Server guide as "AirMobileS" and the Client guide as "AirMobile."

With regard to claim 90, AirMobile disclosed a method of pushing user data items from a messaging host system ("communication server") to a wireless mobile data device that is associated with a computer (i.e. the mobile device in AirMobile is in and of itself a computer) connected over a network to the messaging host system (p. 9, "Communication Server," p. 10, "User Profile Database," pp. 15-16, wherein mail is received and stored at the communication

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server, and the mail account is associated with a mobile device according the device ID), the method comprising the steps of:

- Receiving a notification at a redirector component indicating receipt of a user data item by the messaging host system, where the notification is generated in response to receipt of the user data item at the messaging host system and wherein the user data item is addressed to a data store that is associated with the messaging host system and is viewable via the computer (e.g. Airmobile pushes received messages to the mobile clients and this push algorithm is invoked by some internal notification; see inter alia pgs 30 and 31 “enables messages to be immediately downloaded when they are received”];
- Processing the user data item at the redirector component to add address information associated with the wireless mobile data device (required for delivery to the mobile client, see pg 31 ¶s 1-3);
- Sending the user data item from the redirector component to the wireless mobile data device over a wireless network (the actual push or download of the message to the mobile device pg 31, ¶s 1-3).
- Receiving a reply mail item from the wireless mobile data device at the redirector component (e.g. sending reply to the server pg 38);
- Interfacing the reply mail item to the messaging host system by the redirector component such that the reply mail item is sent to the sender (e.g. forwarding the reply to the original sender, pg 38).

AirMobile disclosed the invention substantially as claimed, however Airmobile failed to specifically recite 1) that the *notification is automatically generated* in response to receipt of the user data item, 2) transmitting a *copy* of the received electronic message and 3) using encryption for sending messages between the redirector component and the mobile data device.

With regard to point (1), AirMobile failed to specifically recite that the *notification is automatically generated* in response to receipt of the user data item. AirMobile disclosed a server side push technology (pg 31 ¶ 1-3), where the server must internally poll for the arrival on new messages in a user's mailbox. Nonetheless Examiner maintains that such an automatic notification must occur in the system in order for the actual forwarding software to be invoked within the computer system. Furthermore even if one were to argue persuasively that such a notification is not inherent then Examiner maintains that adding a new data item automatic notification feature would have been an obvious modification to AirMobile at the time of Applicant's invention, in view of at least Carthy. In a similar art, Carthy disclosed an e-mail system where the notification of new messages in a user's mailbox is sent **automatically**, as opposed to polling, using an extended MAPI IMAPIadviseSink notification (See the Carthy post describing "full asynchronous" notification in extended MAPI). Carthy further disclosed that in order to receive these automatic notifications the system must register with a software interface associated with the messaging server (i.e. registering with the ImsgStore to receive adviseSinks). Cathy also disclosed that automatic notification is preferable to polling (see the Cohen post below: "Today I do a polling on each mailbox : I open a connection through MAPI functions, I consult, I notify if new mail, and I close the connection. Then I go to the next mailbox and do

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the same actions. It's not great ☹. So I'd like to know whether –there- exists another way to notify with MAPI, especially a “fully asynchronous” notification”). Automatic notification is preferable to polling for detecting the arrival of new messages since the detection process is more efficient. For example the system no longer has the delay associated with polling each user's mailbox and is instead alerted immediately of the arrival of new messages. Additionally less system resources are consumed since the system no longer has to poll the mailbox of each user in order to detect new messages. Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the automatic notification functionally disclosed by Carthy within AirMobile's system, since Carthy disclosed automatic notification is preferable to polling and further since the use of automatic notification is more efficient. Again automatic notification is more efficient since the system is alerted immediately of the arrival of new messages and less system resources are consumed.

With regard to point (2), AirMobile discloses forwarding messages received at the messaging server to the wireless device. However, AirMobile does not *explicitly* state that the messages forwarded to the wireless mail system are a *copy*. Nonetheless, most e-mail systems that forward messages actually replicate the messages before forwarding, so that a copy of the message is retained in the initial destination mailbox. Such replication is disclosed by Eggleston. In a similar art, Eggleston teaches a system for forwarding messages from a LAN-based host through a wireless host to a mobile client device, wherein the LAN-based host stores messages, thereby maintaining a replica of the messages, before forwarding them to the client (col. 4, lines 44-51; col. 12, lines 32-39, 59-62, wherein the messages are copied and maintained at a host

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system, and are also sent to target units). Thus, given the teaching of Eggleston, a person having ordinary skill in the art would have readily recognized the desirability and advantages of replicating the messages at the messaging server taught by AirMobile, to preserve received messages in case the client memory fails or the message is lost in transmission. Therefore, it would have been obvious to include the mail replication feature taught by Eggleston in the mail forwarding system taught by AirMobile and Carthy.

With regard to point (3), AirMobileS disclosed sending messages from the cc:Mail server to the mobile device in a secure fashion (AirMobileS, p. 25, bullet 1 “secure and authenticated virtual wireless communication channel between your laptop and your LAN-based cc:Mail server”) however, AirMobile does not disclose using encryption for sending messages in a secure fashion. Nonetheless the use of encryption to send messages securely was widely known in the art at the time of Applicant’s invention, as evidenced by at least Murota. In a similar email system, Murota disclosed encrypting e-mail messages between a sender and a receiver, wherein a message is encrypted at the sending end, is then transmitted over the network to the receiving end, and is finally decrypted at the receiving computer (col. 1, lines 23-48). Murota further disclosed that such an encryption scheme is advantageous because it prevents leaks of secret information to outside, non-intended parties (Murota, col. 1, lines 49-53). Thus, given the teaching of Murota, it would have been obvious to one of ordinary skill in the art at the time of Applicant’s invention include an encryption function, as taught by Murota, in conjunction with the redirector component of AirMobile such that messages sent between the AirMobile server

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and mobile devices are encrypted, in order to prevent outside parties from having access to secret or classified messages.

With regard to claim 91, AirMobile disclosed the redirector component is operating on the messaging host system (pg 9 “communication server” and pg 31 ¶s 1-3).

With regard to claim 92, AirMobile disclosed the redirector component is operating on a host system that is couple to the message host system via the network (e.g. the Network fiel server cc:Mail Postoffice works in tandem with the Windows AirMobile server pg 9).

With regard to claim 93, Eggleston disclosed that messages sent between the wired and wireless systems can be compressed (col. 11, lines 63-67). Given this knowledge, it would have been obvious to a person having ordinary skill in the art to compress the messages in the system taught by AirMobile, Carthy, Bezair, and Eggleston, prior to transmission to the gateway, and to decompress the messages at the mobile device, as suggested by Eggleston, in order to increase available bandwidth and to provide faster and less expensive communications (see Eggleston, col. 12, lines 7-9).

With regard to claim 94, AirMobile disclosed the processing step further comprises encoding the copy of the user data item (e.g. transforming a message into the required transmission protocol for the wireless network being utilizing prior to pushing a message to the user) (additionally compressing as set forth with regard to claim 106 is a form of encoding).

With regard to claim 95, Examiner takes official notice that the Multipurpose Internet Mail Extensions protocol was widely known and used to communicate email messages between devices at the time of Applicant's invention. Thus, it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to encode messages using the MIME protocol within AirMobile's system in order to communicate messages between devices using a known reliable protocol.

With regard to claim 96, AirMobile disclosed the data store address is an email mailbox at the messaging host system associated with a user of the computer and the wireless mobile data device ("cc:Mail" address, p. 38, "Sending/Transmitting e-mail messages").

With regard to claim 97, AirMobile disclosed the step of sending the copy of the user data item from the redirector component to the wireless mobile data device over the wireless network further comprises sending the copy of the user data item via a wireless gateway disposed between a wide area network and the wireless network (see pg 9, Figure 1-1, a gateway is required to interface between the networks).

With regard to claim 98, AirMobile disclosed the step of storing the user data item at the data store associated with the messaging host system (p. 9, "Communication Server," p. 10, "User Profile Database," pp. 15-16, wherein mail is received and stored at the communication server, and the mail account is associated with a mobile device according the device ID).

Claims 99-109 are rejected using a similar rationale as applied to claims 90-98.

Conclusion

2. The prior art made of record, in PTO-892 form, and not relied upon is considered pertinent to applicant's disclosure.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sean Reilly whose telephone number is 571-272-4228. The examiner can normally be reached on M-F 8-5.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glen Burgess can be reached on 571-272-3949. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

June 20, 2006


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